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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,321	11/26/2001	Peter T. O'Heeron	18408.0016	7380

7590 10/15/2003

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EXAMINER

THALER, MICHAEL H

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 10/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/994,321

Applicant(s)

O'HEERON ET AL.

Examiner

Michael Thaler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 6-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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The disclosure is objected to because of the following informalities: In claim 6, paragraph (c) (ii), "element" should be "elements". Appropriate correction is required.

Claim 11 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The feature defined in claim 11 appears in claim 6 paragraph (c).

Claims 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sauer et al. (5,441,041) and Goodwin et al. (5,817,061), each in view of the other. Sauer al. disclose housing assembly 52, cannula assembly 54, obturator assembly 12 comprising a shaft 20 having a piercing end with a piercing tip (figure 4) with an upper face (e.g. 28f) and a lower face (e.g. 28g) which taper from the shaft, insert blade 34 comprising a non-conical head (at the tip) and two wing elements (the sides which form an obtuse angle) having lateral edges. The Sauer et al. disclosure is silent as to whether the blade head is blunt or sharp. However, Goodwin et al. teach that blade edges on an obturator tip should be blunt in order to perform blunt dissection of tissue (col. 4, llines 36-39). This has the self-evident advantage of preventing inadvertent

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cutting of tissue while still permitting the dissection of tissue when desired. It would have been obvious to make the blade edges of Sauer al. blunt so that it too would have this advantage. With this modification, the head of the Sauer et al. blade (at the tip) would be blunt as claimed. Sauer et al. fail to disclose the piecing tip as being removable from the shaft. However, Goodwin et al. teach that a piercing tip of a trocar should be removable from the shaft so that it can be replaced with another tip (col. 4, lines 19-26 and col. 5, lines 20-29). It would have been obvious to make the Sauer et al. piecing tip removable from the shaft so that it too would have this advantage. Alternatively, Goodwin et al. disclose blunt edged blades 18 but fail to disclose that they meet to form a single "blade". However, Sauer et al. teach that blade edges (at 34) on a conical obturator should extend<sup>d</sup> to the tip (or head) of the obturator and meet and thus form a blade apparently in order to dissect tissue effectively (col. 5, lines 19-24). It would have been obvious to extend blades 18 of Goodwin et al. to the tip of the obturator and meet and thus form a blade so that it too would have this advantage. As to claim 7, neither reference discloses metal as the blade material. However, it was well known to use metal as the material for obturator blades so

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that they are strong. It would have been obvious to make the blade of either reference metal so that it too would have this advantage.

Applicant's arguments with respect to claims 6-11 have been considered but are moot in view of the new ground(s) of rejection. Note that the amendment to claim 6 has made the claim broader since the claimed features of conical shaped points and beveled lateral edges have been deleted from the claim.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703)308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3590 for regular communications and (703)305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

mht  
October 10, 2003



MICHAEL THALER  
PRIMARY EXAMINER  
ART UNIT 3731